

REMARKS

In this paper, claims 1 and 37 are currently amended. After entry of the above amendment, claims 1-53 are pending.

The filing receipt and Office Action contain spelling errors in the names of the inventors. “Kirmoto” should be “Kirimoto,” and “Yamahita” should be “Yamashita.” The errors appear to be PTO errors, since the correct spellings appear on the originally filed documents.

Claims 37-53 were rejected under 35 U.S.C. §251 as being improperly broadened by attempting to recapture previously surrendered subject matter. This basis for rejection is respectfully traversed.

The *Pannu* case cited in the office action is not applicable to the present situation. *Pannu* is a typical recapture case wherein a limiting feature was added to an existing element, and then that limiting feature was deleted in the reissue proceeding. More specifically, original claim 1 in the *Pannu* patent recited an intraocular lens comprising a lens body and at least two spaced flexible positioning and supporting elements integrally formed with the lens body. During prosecution, claim 1 was amended to distinguish over the prior art by reciting the positioning and supporting elements “defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference.” That feature of the positioning and supporting elements was deleted in a reissue proceeding. The Court held that the deletion of the added feature constituted an impermissible recapture of previously surrendered subject matter.

In *Meyers*, the claims were directed to features of a night vision system. Each original claim included a pulsing circuit for a light-emitting diode (LED). During prosecution, the patentee distinguished over the prior art by amended the pulsing circuit to add two limitations: (1) that the circuit would pulse on and off at intervals that resulted in the LED being off more often than on; and (2) that the pulsing circuit, when on, would pulse at a substantially higher level of power than it would be able to sustain if left on continuously. The pulsing circuit, including the two added

features, was deleted from the claims. The Court held that deletion of the pulsing circuit, together with the two features added to the pulsing circuit to distinguish over the prior art, did not constitute impermissible recapture.

These two cases can be understood by the following analogy: If a claim recites  $A + B + C$  and is amended during prosecution to recite  $A + B + C + C'$ , wherein  $C'$  is a feature of element  $C$ , then  $C'$  cannot be deleted in a reissue proceeding. That is the *Pannu* case. However, if a claim recites  $A + B + C$  and is amended during prosecution to recite  $A + B + C + C'$ , wherein  $C'$  is a feature of element  $C$ , then the claim may be amended in a reissue proceeding to delete  $C$  and  $C'$  and recite  $A + B + D$ , wherein feature  $D$  is a narrowing feature independent of element  $C$ . That is the *Meyers* case. The patentee was not attempting to recapture protection of  $A + B + C$ , but was attempting to protect an independent invention  $A + B + D$ .

The present application is similar to *Meyers* in that the original claims recited “first and second cam members”, i.e., element “C.” During prosecution of the original patent, the first and second cam members were amended to include their respective input and output designations as well as the movement and camming surface features. The added features collectively can be called feature  $C'$ . If the preliminary amendment merely deleted the input and output designations as well as the movement and camming surface features and otherwise kept the two cam members, then the examiner would be correct that *Pannu* prevents such an amendment.

However, there is a difference between deleting a limiting *feature* that was added to an element versus deleting the element itself. *Pannu* applies to the former, whereas *Meyers* applies to the latter. In other words, the preliminary amendment in this case canceled not just feature  $C'$ , but element  $C$  (the two cams) as well. The actuating arm (equivalent to “element  $D$ ”) was added to protect an invention that is independent of an invention that involves the cams.

Claims 1-3, 6, 7, 11-15, 21-25, 32 and 36 were rejected under 35 U.S.C. §102(b) as being anticipated by Carre, et al (US 4,582,577). This basis for rejection is respectfully traversed.

Claim 1 has been amended to clarify that the housing has a mounting bracket structured and dimensioned to be attached to a bicycle. Carre, et al discloses a braking device installed on heavy motor vehicles. Carre, et al neither discloses nor suggests a housing with a mounting bracket structured and dimensioned to be attached to a bicycle.

Claims 37-45 and 47-49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Le Deit, et al (US 5,647,475) in view of Carre, et al. This basis for rejection is respectfully traversed.

Le Deit, et al also is directed to a braking device for a motor vehicle and neither discloses nor suggests a housing with a mounting bracket structured and dimensioned to be attached to a bicycle. Additionally, the references are nonanalogous art. Both references are from the field of motor vehicles. Furthermore, Carre, et al is directed to the problem of making torque exerted on the rotary member of an actuation device of a brake motor independent of the stroke of the output member of a control jack. The present invention is not at all concerned with such problems. Instead, the present invention is directed to aligning a cable that exits from an opening in a cable support disposed on a bicycle caliper housing.

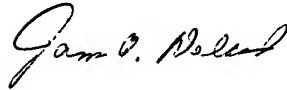
Claims 50-53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Le Deit, et al in view of Carre, et al and Huang (US 6,199,669). This basis for rejection is respectfully traversed for the reasons noted above, especially in view of the fact that both Le Deit and Carre, et al are nonanalogous art with respect to Huang.

Accordingly, it is believed that the rejections under 35 U.S.C. §102, §103 and §251 have been overcome by the foregoing amendment and remarks, and it is submitted that the claims are in condition for allowance. Reconsideration of this application as amended is respectfully requested. Allowance of all claims is earnestly solicited.

KANJI KIRIMOTO, et al  
Application No.: 10/826,173  
Page 7

PATENT

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "James A. Deland".

James A. Deland  
Reg. No. 31,242

DELAND LAW OFFICE  
P.O. Box 69  
Klamath River, California 96050  
(530) 465-2430